UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,973	01/29/2002	Jeremy Bunn	10018307 -1	5646

7590 10/17/2005	EXAMINER
HEWLETT-PACKARD COMPANY	POKRZYWA, JOSEPH R

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ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/062,973	BUNN ET AL.
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>19 January 2002</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>8/22/05, 5/25/05 & 1/29/02</u>

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Information Disclosure Statement

1.   The references listed in the Information Disclosure Statement submitted on 8/22/05,

5/25/05, and 1/29/02 have been considered by the examiner (see attached PTO-1449).

Drawings

2.   The drawings received on 1/19/02 are acceptable by the examiner.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   **Claims 23-25** are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter. Claims 54, 65, 73, 82, and 83 are drawn to functional descriptive

material NOT claimed as residing on a computer readable medium.   MPEP 2106.IV.B.1(a)

(Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Claims 23-25, while defining a program product, does not define a "computer-readable

medium" and is thus non-statutory for that reasons. A program product can range from paper on

which the program is written, to a program simply contemplated and memorized by a person.

The examiner suggests amending the claims to embody the program product on "computer-

readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure
defines structural and functional interrelationships between the data structure and the computer
software and hardware components which permit the data structure's functionality to be realized,
and is thus statutory." - MPEP 2106.IV.B.1(a)

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

6.   **Claims 1-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Smith, II *et al.*

(U.S. Patent Application Publication 2002/0113994).

The applied reference has a common assignee with the instant application. Based upon

the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not the invention "by another," or by an appropriate

showing under 37 CFR 1.131.

Regarding *claim 1*, Smith discloses a method of printing using a mobile device (see

abstract, and Figs. 1, 2, and 9A-11B), comprising accessing remote content (paragraphs 0039-

0041), generating on the mobile device an archive file containing the remote content (paragraphs

0039-0041), transmitting a print request to an imaging device (paragraphs 0040-0041), receiving

a file request from the imaging device for the archive file (paragraphs 0040-0041); and

transmitting the archive file to the imaging device (paragraphs 0040-0041), whereby the imaging

device prints the content (paragraphs 0007, and 0040-0041).

Regarding *claim 2*, Smith discloses the method discussed above in claim 1, and further

teaches that the print request includes a reference that indicates a location of the archive file

(paragraphs 0040-0041).

Regarding *claim 3*, Smith discloses the method discussed above in claim 1, and further

teaches that the remote content comprises a web page that contains a link to referenced content,

and wherein the step of generating an archive file comprises rewriting the link to refer to a

referenced content file in the archive file (paragraphs 0040-0041).

Regarding *claim 4*, Smith discloses the method discussed above in claim 1, and further

teaches that the steps of transmitting the print request to the imaging device and transmitting the

archive file to the imaging device each comprise transmitting using a wireless communication

protocol (paragraphs 0033-0035, and 0040-0041).

Regarding *claim 5*, Smith discloses the method discussed above in claim 1, and further teaches of rendering the archive file on the imaging device to create rendered content, and printing the rendered content (paragraphs 0041, and 0051).

Regarding *claim 6*, Smith discloses the method discussed above in claim 1, and further teaches of transmitting the archive file from the imaging device to a print service paragraphs (0033-0035, 0040-0041, and 0050-0052); rendering the archive file on the print service to create rendered content (0033-0035, 0040-0041, and 0050-0052), and transmitting the rendered content from the print service to the imaging device, whereby the imaging device prints the rendered content (0033-0035, 0040-0041, and 0050-0052).

Regarding *claim 7*, Smith discloses the method discussed above in claim 6, and further teaches that the archive file comprises an HTML file and wherein the print service comprises an HTML rendering engine (paragraphs 0003, 0028, and 0047).

Regarding *claim 8*, Smith discloses the method discussed above in claim 1, and further teaches that the remote content is located behind a firewall on a secure server, and the step of accessing the remote content comprises transmitting security information from the mobile device to the secure server (paragraphs 0049-0050).

Regarding *claim 9*, Smith discloses a method of printing using a mobile device (see abstract, and Figs. 1, 2, and 9A-11B), comprising accessing remote content, generating on a proxy server an archive file containing the remote content (paragraphs 0040-0041), transmitting a print request to an imaging device, the print request including a reference that indicates a location of the archive file on the proxy server (paragraphs 0040-0041); receiving a file request at the proxy server from the imaging device for the archive file (paragraphs 0040-0041); and

transmitting the archive file from the proxy server to the imaging device, whereby the imaging

device prints the content (paragraphs 0007, and 0040-0041).

Regarding *claim 10*, Smith discloses the method discussed above in claim 9, and further

teaches that the remote content comprises a web page that contains a link to a referenced image,

and wherein the step of generating an archive file comprises rewriting the link to refer to a

referenced image file in the archive file (paragraphs 0033-0035, and 0040-0041).

Regarding *claim 11*, Smith discloses the method discussed above in claim 9, and further

teaches that the step of transmitting the print request to the imaging device comprises

transmitting using a wireless communication protocol (paragraphs 0033-0035, and 0040-0041).

Regarding *claim 12*, Smith discloses the method discussed above in claim 9, and further

teaches that the step of generating on a proxy server an archive file further comprises generating

the archive file in a format that may be rendered by the imaging device (paragraphs 0041, and

0051).

Regarding *claim 13*, Smith discloses the method discussed above in claim 9, and further

teaches of transmitting the archive file from the imaging device to a print service paragraphs

(0033-0035, 0040-0041, and 0050-0052); rendering the archive file on the print service to create

rendered content (0033-0035, 0040-0041, and 0050-0052), and transmitting the rendered content

from the print service to the imaging device, whereby the imaging device prints the rendered

content (0033-0035, 0040-0041, and 0050-0052).

Regarding *claim 14*, Smith discloses the method discussed above in claim 13, and further

teaches that the archive file comprises an HTML file and wherein the print service comprises an

HTML rendering engine (paragraphs 0003, 0028, and 0047).

Regarding *claim 15*, Smith discloses the method discussed above in claim 9, and further

teaches that the remote content is located behind a firewall on a secure server, and the step of

accessing the remote content comprises transmitting security information from the mobile device

to the secure server (paragraphs 0049-0050).

Regarding *claim 16*, Smith discloses a method of printing using a mobile device (see

abstract, and Figs. 1, 2, and 9A-11B), comprising accessing remote content, generating on a

proxy server an archive file containing the remote content (paragraphs 0040-0041); transmitting

a print request to an imaging device, receiving a file request from the imaging device for the

archive file (paragraphs 0040-0041); transmitting the file request to the proxy server; receiving

the archive file from the proxy server in a data stream (paragraphs 0040-0041, and 0049-0051),

and streaming the data stream of the archive file from the mobile device to the imaging device

(paragraphs 0049-0052), whereby the imaging device prints the content (paragraphs 0007, 0040-

0041, and 0049-0052).

Regarding *claim 17*, Smith discloses the method discussed above in claim 16, and further

teaches that the remote content comprises a web page that contains a link to a referenced image,

and wherein the step of generating an archive file comprises rewriting the link to refer to a

referenced image file in the archive file (paragraphs 0033-0035, and 0040-0041).

Regarding *claim 18*, Smith discloses the method discussed above in claim 16, and further

teaches that the step of transmitting the print request to the imaging device comprises

transmitting using a wireless communication protocol (paragraphs 0033-0035, and 0040-0041).

Regarding *claim 19*, Smith discloses the method discussed above in claim 16 and further

teaches that the step of generating on a proxy server an archive file further comprises generating

the archive file in a format that may be rendered by the imaging device (paragraphs 0041, and

0051).

Regarding *claim 20*, Smith discloses the method discussed above in claim 16, and further

teaches of transmitting the archive file from the imaging device to a print service paragraphs

(0033-0035, 0040-0041, and 0050-0052); rendering the archive file on the print service to create

rendered content (0033-0035, 0040-0041, and 0050-0052), and transmitting the rendered content

from the print service to the imaging device, whereby the imaging device prints the rendered

content (0033-0035, 0040-0041, and 0050-0052).

Regarding *claim 21*, Smith discloses the method discussed above in claim 20, and further

teaches that the archive file comprises an HTML file and wherein the print service comprises an

HTML rendering engine (paragraphs 0003, 0028, and 0047).

Regarding *claim 22*, Smith discloses the method discussed above in claim 16, and further

teaches that the remote content is located behind a firewall on a secure server, and the step of

accessing the remote content comprises transmitting security information from the mobile device

to the secure server (paragraphs 0049-0050).

Regarding *claim 23*, Smith discloses a computer program product for mobile printing

(see abstract, and Figs. 1, 2, and 9A-11B) comprising code that accesses remote content

(paragraphs 0039-0041), code that generates on the mobile device an archive file containing the

remote content (paragraphs 0039-0041), code that transmits a print request to an imaging device

(paragraphs 0040-0041), code that receives a file request from the imaging device for the archive

file(paragraphs 0040-0041); and code that transmits the archive file to the imaging device

(paragraphs 0040-0041), whereby the imaging device prints the content (paragraphs 0007, and 0040-0041).

Regarding *claim 24*, Smith discloses a computer program product for mobile printing (see abstract, and Figs. 1, 2, and 9A-11B) comprising code that accesses remote content (paragraphs 0040-0041), code that generates on a proxy server an archive file containing the remote content (paragraphs 0040-0041), code that transmits a print request to an imaging device, the print request including a reference that indicates a location of the archive file on the proxy server (paragraphs 0040-0041); code that receives a file request at the proxy server from the imaging device for the archive file (paragraphs 0040-0041); and code that transmits the archive file from the proxy server to the imaging device, whereby the imaging device prints the content (paragraphs 0007, and 0040-0041).

Regarding *claim 25*, Smith discloses a computer program product for mobile printing (see abstract, and Figs. 1, 2, and 9A-11B) comprising code that accesses remote content (paragraphs 0040-0041), code that generates on a proxy server an archive file containing the remote content (paragraphs 0040-0041), code that transmits a print request to an imaging device, the print request including a reference that indicates a location of the archive file on the proxy server (paragraphs 0040-0041); code that receives a file request from the imaging device for the archive file (paragraphs 0040-0041, and 0049-0051); code that transmits the file request to the proxy server; code that receives the archive file from the proxy server in a data stream, and code that streams the data stream of the archive file from the mobile device to the imaging device (paragraphs 0049-0052), whereby the imaging device prints the content (paragraphs 0007, 0040-0041, and 0049-0052).

Citation of Pertinent Prior Art

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure:

      Pineau (U.S. Patent Number 6,922,258) discloses a system of printing remote images
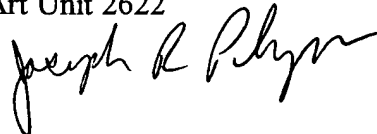
using a mobile device.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The

examiner can normally be reached on Monday-Friday, 9:00-5:00.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

      Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                              Joseph R. Pokrzywa
                              Primary Examiner
                              Art Unit 2622

jrp